

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Application of: Li <i>et al.</i> | Confirmation No.: 2965 |
| Patent No. 7,674,797 | Issue date: March 9, 2010 |
| Serial No.: 10/550,482 | Art Unit: 1624 |
| 371(c) date: October 13, 2006 | Examiner: Jarrell, Noble E. |
| For: 2-PHENOXY- AND 2-PHENYLSULFONAMIDE DERIVATIVES WITH CCR3 ANTAGONISTIC ACTIVITY FOR THE TREATMENT OF ASTHMA AND OTHER INFLAMMATORY OR IMMUNOLOGICAL DISORDERS | Attorney Docket No: 12702-004-999 (CAM: 191354-999004) |

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Patentees respectfully request reconsideration of the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) ("Determination") stated on the Issue Notification of February 17, 2010 in connection with the above-captioned application. This Application is timely filed pursuant to 37 C.F.R. § 1.705(d) as this paper is filed within two months of the issuance of the above-captioned patent.

The patent term adjustment under 35 U.S.C. § 154(b) indicated on the Determination is 362 days. Applicants respectfully disagree. As set forth below, the correct patent term adjustment is 365 days.

A. Statement of Facts Under 37 C.F.R. § 1.705(b)(2)

Pursuant to 37 C.F.R. § 1.702, Applicants submit the following statement of facts in support of this Application for Patent Term Adjustment.

The patent term adjustment due to Office delays is the sum of Office delays under 35 U.S.C. § 154(b)(1)(A) and 35 U.S.C. § 154(b)(1)(B), minus Applicants' delay under 37 C.F.R. § 1.704. The details of this calculation are provided below.

1. Patent Office Delays Under 35 U.S.C. §154(b)(1)(A)

Applicants respectfully submit that Office delay under 35 U.S.C. § 154(b)(1)(A)(i) is 149 days.

This application is a National Stage Filing under 35 U.S.C. § 371. The national stage commenced on September 24, 2005, and the requirements of 35 U.S.C. § 371 were fulfilled on October 13, 2006. Thus, a first action was due December 13, 2007, *i.e.*, fourteen months after the application fulfilled the requirements of 35 U.S.C. § 371. *See* 37 C.F.R. § 1.703(a)(1) (patent term adjustment is equal to the number of days “in the period beginning on the day after the date that is fourteen months after the date on which the application...fulfilled the requirements of 35 U.S.C. § 371...and ending on the date of mailing of...an action under 35 U.S.C. § 132....”); 35 U.S.C. § 154(b)(1)(A)(i). A Restriction Requirement was mailed April 17, 2008. Thus, the period of Office delay for failure to issue an action within 14 months is 126 days.

The Issue Fee was paid and received by the Office on October 14, 2009. The above-captioned patent issued on March 9, 2010. Thus, the period of Office delay for failure to issue a patent within four months (*i.e.*, February 14, 2010) after the issue fee was paid is 23 days. *See* 37 C.F.R. § 1.703(a)(6).

The total PTO delay under 35 U.S.C. § 154(b)(1)(A) is $126 + 23 = \underline{149 \text{ days}}$.

2. Patent Office Delays Under 35 U.S.C. §154(b)(1)(B)

Applicants respectfully submit that Office delay under 35 U.S.C. § 154(b)(1)(B) is 217 days.

According to 35 U.S.C. § 154(b)(1)(B), the term of a patent is extended “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application...not including (i) any time consumed by continued examination of the application requested by the application under section 132(b)...” 35 U.S.C. § 154(b)(1)(B). The “actual filing date” for a National Stage Filing under 35 U.S.C. § 371 is the date on which the national stage commenced under 35 U.S.C. § 371(b) or (f). *See* 37 C.F.R. § 1.702(b). As discussed above, the national stage commenced on September 24, 2005. Thus, the three-year anniversary of

the actual filing date is September 24, 2008. Applicants filed a Request for Continued Examination on April 28, 2009. Thus, because the period between April 28, 2009 and the issuance of a patent is excluded from patent term adjustment calculations, the period of Office delay under 35 U.S.C. § 154(b)(1)(B) is 216 days.

3. Total Patent Office Delays

The patent term adjustment due to Office delays is the sum of Office delays under 35 U.S.C. § 154(b)(1)(A) and 35 U.S.C. § 154(b)(1)(B). See *Wyeth v. Dudas*, 88 U.S.P.Q.2d 1538 (D.D.C. 2008), *aff'd*, *Weyeth v. Kappos*, No. 2009-1120 (Fed. Cir. 2010). However, “[t]o the extent that period of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.” *Id.* at 1539, citing 35 U.S.C. § 154(b)(2)(A). Overlap occurs “only if they occur on the same calendar day or days.” *Id.* at 1541.

As discussed above, the Office delay under 35 U.S.C. § 154(b)(1)(A) occurred from December 13, 2007 to April 17, 2008, and from February 14, 2010 to March 9, 2010. The period of Office delay under 35 U.S.C. § 154(b)(1)(B) was between September 23, 2008 and April 28, 2009. No calendar days overlap in these periods. Thus, the total patent term adjustment due to Office delay is $149 + 216 = 365$ days.

4. Applicants’ Delay under 37 C.F.R. § 1.704

Applicants agree with the Office’s determination that there were no instances of Applicant delay under 37 C.F.R. § 1.704.

B. Statement of Terminal Disclaimers Under 37 C.F.R. § 1.705(b)(2)(iii)

Pursuant to 37 C.F.R. § 1.702(b)(2)(iii), an Application for Patent Term Adjustment must be accompanied by a statement disclosing whether the application is subject a terminal disclaimer, and if so, the expiration date specified in the terminal disclaimer. No terminal disclaimers were filed in the above-captioned application. Therefore, the correct patent term adjustment is 365 days.

C. Conclusion

The fee of \$200.00 required under 37 C.F.R. §1.18(e) will be paid via EFS Web. If any additional fees are due, the Commissioner is authorized to charge them to Deposit Account No. 50-3013 (referencing 191354-999004).

Respectfully submitted,

Date: May 4, 2010



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